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09/534,433

03/23/2000

David L. Patton

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1333 7590 06/19/2008  
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EXAMINER

CARTER, MONICA SMITH

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* DAVID L. PATTON

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Appeal 2008-0764  
Application 09/534,433  
Technology Center 3700

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Decided: June 19, 2008

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Before WILLIAM F. PATE, III, JENNIFER D. BAHR, and MICHAEL W.  
O'NEILL, *Administrative Patent Judges*.

BAHR, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

This application is remanded to the Examiner, pursuant to 37 C.F.R.  
§ 41.50(a)(1), for appropriate action with regard to the following issues.

David L. Patton (Appellant) appeals under 35 U.S.C. § 134 from the  
Examiner's decision rejecting claims 12, 14, 18-23, 25, and 29-34.<sup>1</sup> This is

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<sup>1</sup> Claims 1-11, 13, 15-17, 24, and 26-28 have been canceled.

the Appellant's second appeal before the Board of Patent Appeals and Interferences. In the first appeal (2005-1291, Decision mailed July 25, 2005), the decision of the Examiner to reject claims 12, 14, 18-23, 25, and 29-34 under 35 U.S.C. § 103(a) was reversed. We have jurisdiction over this appeal under 35 U.S.C. § 6 (2002).

In the Final Rejection mailed June 9, 2006, the Examiner rejected claims 12, 14, 19-21, 23, 30-32, and 34 under 35 U.S.C. § 102(b) as being anticipated by Guttag (US 5,120,089, issued June 9, 1992) or, in the alternative, under 35 U.S.C. § 103(a) as being unpatentable over Guttag in view of Denenberg (US 5,673,338, issued September 30, 1997) and further in view of Schlauch (US 6,082,774, issued July 4, 2000) (Page 2 of the Final Rejection), and claims 18, 22, 29, and 33 under 35 U.S.C. § 103(a) as being unpatentable over Guttag in view of Denenberg and Schlauch, and further in view of Martin (US 5,601,683, issued February 11, 1997) or Burnham (US 4,884,828, issued December 5, 1989) (Page 5 of the Final Rejection).

In the Appeal Brief filed on September 21, 2006, under the heading of "Grounds of Rejection to be Reviewed on Appeal," the Appellant states that the issue of the instant appeal is whether the invention of claims 12, 14, 18-23, 25, and 29-34 is anticipated under 35 U.S.C. § 102(b) over Guttag or, in the alternative, unpatentable under 35 U.S.C. § 103(a) over Guttag in view of Denenberg and Schlauch (App. Br. 3). In the "Arguments" section of the Appeal Brief, the Appellant likewise addresses only a single rejection of claims 12, 14, 18-23, and 29-34 under 35 U.S.C. § 102(b) over Guttag or, in the alternative, under 35 U.S.C. § 103(a) over Guttag in view of Denenberg and Schlauch (App. Br. 4). Upon a careful review of the Appeal Brief it appears that the Appellant has omitted the rejection of claims 18, 22,

29, and 33 under 35 U.S.C. § 103(a) as unpatentable over Guttag in view of Denenberg and Schlauch, and further in view of Martin or Burnham and has grouped all of the pending claims 12, 14, 18-23, 25, and 29-34 under a single rejection under 35 U.S.C. § 102(b) over Guttag, or, in the alternative, under 35 U.S.C. § 103(a) over Guttag in view of Denenberg and further in view of Schlauch. Although the Appellant's characterization of the rejection appears to omit any reliance on the teachings of Martin and Burnham, we note that the Appellant specifically refers to Martin and Burnham in his arguments (App. Br. 7).

In the Examiner's Answer mailed on March 9, 2007, under the heading of "Grounds of Rejection to be Reviewed on Appeal," the Examiner agrees with the Appellant's statement of the grounds of rejection (Ans. 3). Specifically, the Examiner states that the ground(s) of rejection in the instant appeal is the rejection of claims 12, 14, 18-23, 25, and 29-34 as being anticipated under 35 U.S.C. § 102(b) over Guttag or, in the alternative, as unpatentable under 35 U.S.C. § 103(a) over Guttag in view of Denenberg and further in view of Schlauch (Ans. 3). Therefore, like the Appellant, the Examiner omits the separate rejection of claims 18, 22, 29, and 33 under 35 U.S.C. § 103(a) over Guttag in view of Denenberg and Schlauch, and further in view of Martin or Burnham and groups all of the pending claims 12, 14, 18-23, 25, and 29-34 under a single rejection under 35 U.S.C. § 102(b) over Guttag or, in the alternative, under 35 U.S.C. § 103(a) over Guttag in view of Denenberg and further in view of Schlauch. Although the Examiner does not mention Martin or Burnham in either the statement of the rejection or in the response to arguments in the Answer, the Examiner does list both Martin and Burnham as "Evidence Relied Upon" (Ans. 3), thus giving the

impression that Martin and Burnham are relied upon in the rejection(s) involved in the appeal.

In light of the conflicting indications discussed above, the record is unclear as to which grounds of rejection are under appeal. Specifically, it is unclear whether the final rejection of claims 18, 22, 29, and 33 under 35 U.S.C. § 103(a) as being unpatentable over Gutttag in view of Denenberg and Schlauch, and further in view of Martin or Burnham has been withdrawn in favor of a new ground of rejection of these claims under 35 U.S.C. § 102(b) as being anticipated by Gutttag or, in the alternative, under 35 U.S.C. § 103(a) as being unpatentable over Gutttag in view of Denenberg and further in view of Schlauch.

This application is therefore remanded to the Examiner to make a determination, on the record, as to the grounds of rejection which are under appeal, while also giving the Appellant an opportunity to respond thereto. In response to this remand, the Examiner must clarify whether: (1) the Appellant's statement in the Appeal Brief of the grounds of rejection to be reviewed on appeal is incorrect or (2) the final rejection of claims 18, 22, 29, and 33 under 35 U.S.C. § 103(a) as being unpatentable over Gutttag in view of Denenberg and Schlauch, and further in view of Martin or Burnham is being withdrawn in favor of a new ground of rejection of these claims under 35 U.S.C. § 102(b) as being anticipated by Gutttag or, in the alternative, under 35 U.S.C. § 103(a) as being unpatentable over Gutttag in view of Denenberg and further in view of Schlauch.

Appeal 2008-0764  
Application 09/534,433

This remand to the Examiner pursuant to 37 C.F.R. § 41.50(a)(1) is made for further consideration of a rejection. Accordingly, 37 C.F.R. § 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this remand by the Board.

REMANDED

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